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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,093	02/26/2002	Jeffrey J. Shea	10557/266546	5422
30559 7590 07/18/2007 CHIEF PATENT COUNSEL SMITH & NEPHEW, INC. 1450 BROOKS ROAD MEMPHIS, TN 38116			EXAMINER RAMANA, ANURADHA	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 07/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/083,093

Applicant(s)

SHEA ET AL.

Examiner

Anu Ramana

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 53 is objected to because of the following informalities. In line 9, - - the - - should be inserted after "at" and before "cylindrical" to correct a minor typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 47-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 47, the limitation, "adapted to receive at least an aperture cover, a screw, and a peg" renders the claim vague and indefinite since the functional recitation seems to imply that the opening receives the aperture cover, a screw and a peg simultaneously.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

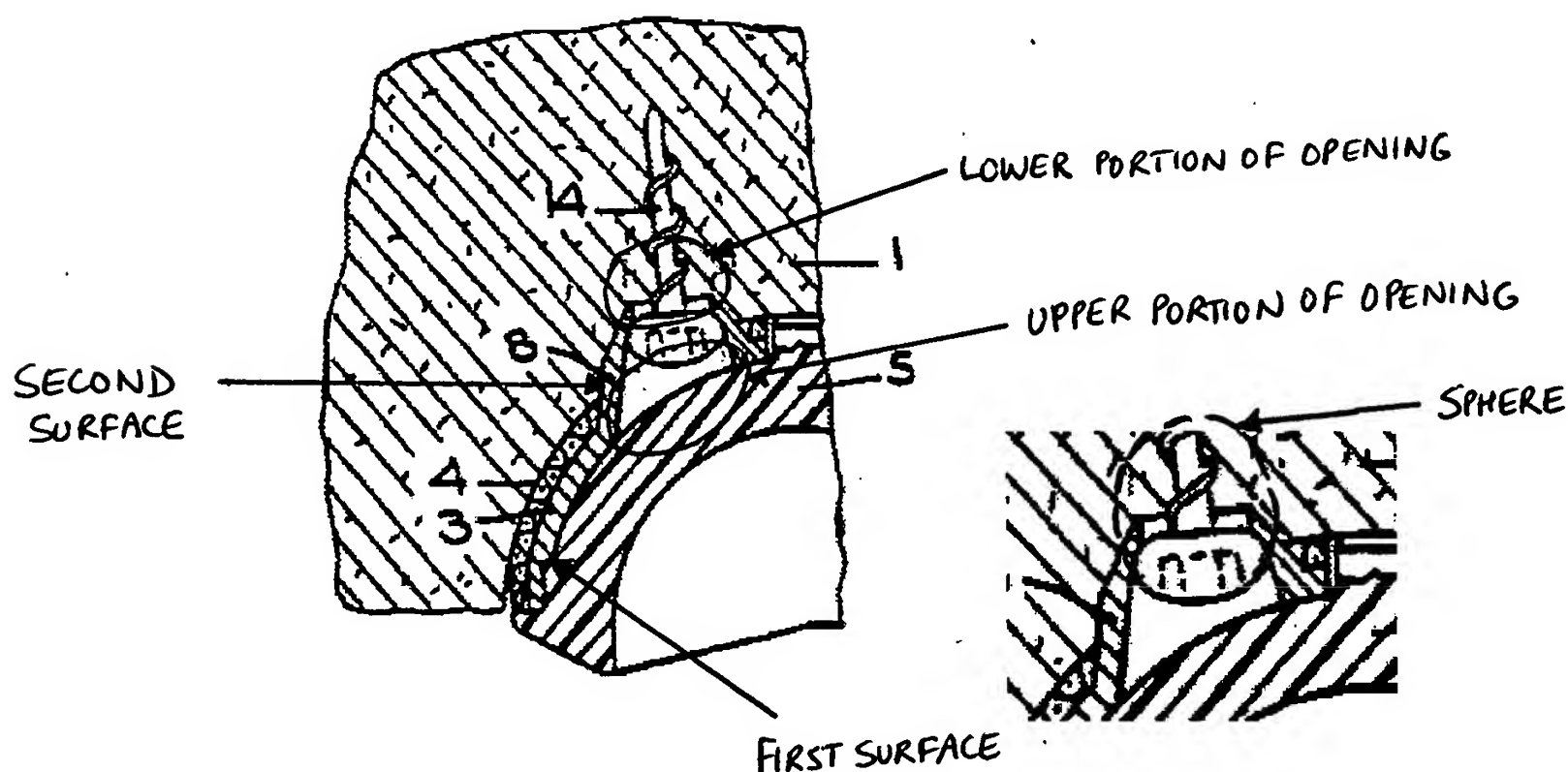
Claims 47-50 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Marchetti et al. (US 5,156,625).

Marchetti et al. disclose an implantable prosthesis including: a metal shell or "prosthetic component" 3; at least one opening extending from a first surface to the second surface of component 3, the opening having a nonthreaded frustoconical upper portion and a lower portion; a screw or "insertion member" 14 with a rounded non-frustoconical contact surface that contacts the frustoconical taper section of the opening and does not contact the lower portion of the opening (Fig. 4, col. 2, lines 39-68 and col. 3, lines 1-44). See marked up Fig. 4 from Marchetti et al. below.

Regarding the limitation, "in a substantially fluid tight relationship" it is noted that the head of screw 14 forms a seal by the head of the screw abutting against the conical surface of the opening. Turning to Applicants' specification to determine what constitutes a "substantially fluid-tight seal," at page 23, line 21 and page 24, lines 1-2, Applicants' disclose that a head of an insertion member should be received and locked in a screw hole to provide "at least a partial seal." The screw 14 of Marchetti et al. forms "at least a partial seal" by being received and locked in the opening and thus fits in the opening in a "substantially fluid tight" relationship.

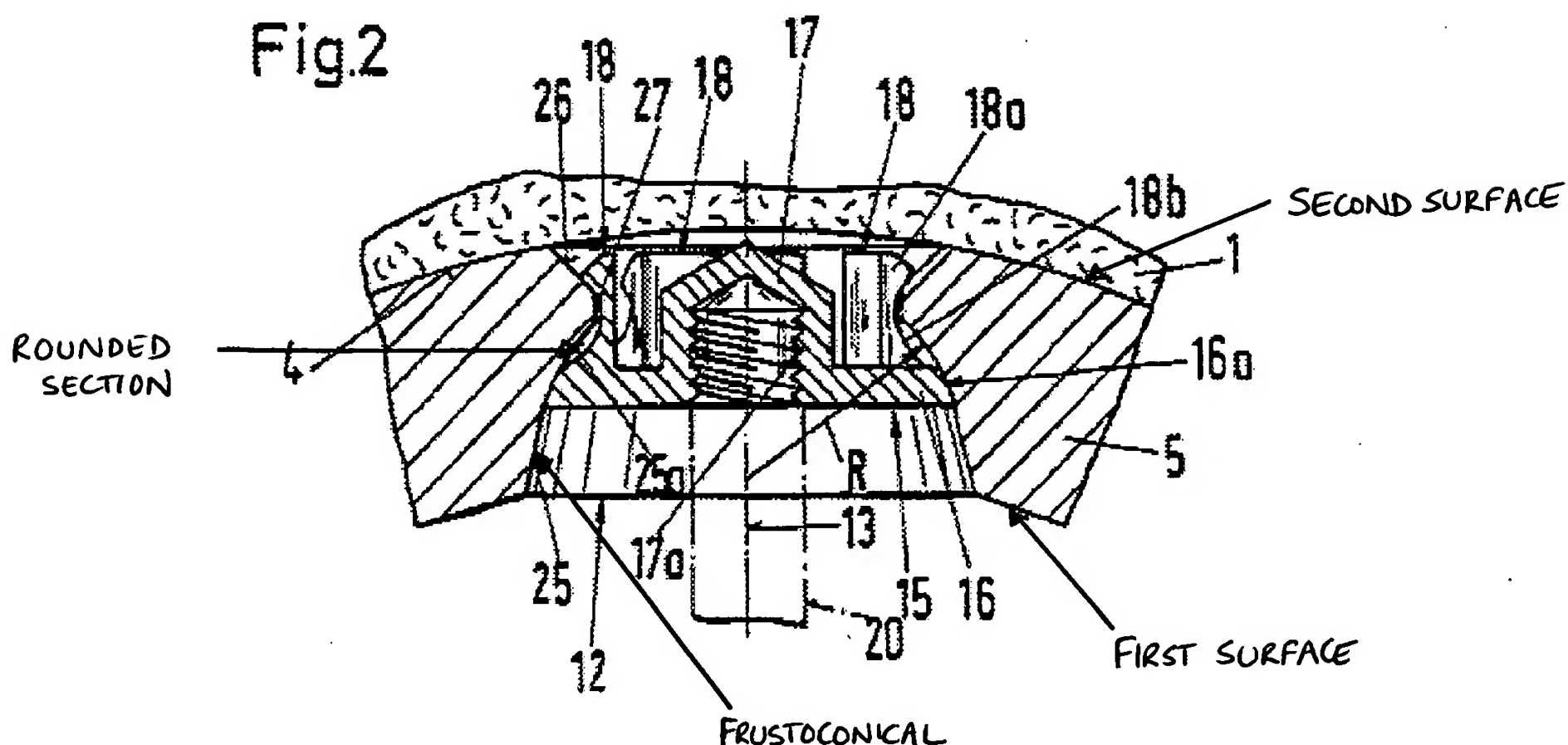
The rounded surface of the head of insertion member 14 is a slice or portion of a sphere as shown in marked up Fig. 4 below.

It is noted that the head of screw 14 abuts on the conical inner wall and thus provides a liquid-tight seal in that there is no opening or gap at the locking interface.



Claims 47-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Oehy et al. (US 5,645,606).

Oehy et al. disclose an acetabular shell or cup 5 having: a first surface, a second surface oriented toward bone; openings 12 extending from the first surface to the second surface wherein each opening 12 has an extended nonthreaded frustoconical taper section 25, a rounded section with a concave surface 25a beginning at a narrow end of the frustoconical section; each opening 12 capable of receiving any type of fastening element or insertion member; an insertion member 14 having a head with a spherical undersurfaces 14a seatable in surface 25a in a plurality of angular positions (Figs. 1-2, col. 2, lines 45-67, col. 3 and col. 4, lines 1-6). See marked up Fig. 2 below.



Response to Arguments

Applicant's arguments submitted under "REMARKS" in the response filed on July 9, 2007 have been fully considered but are not persuasive for the following reasons.

Regarding the rejection of claim 47 as being anticipated by Marchetti et al., the head of insertion member is part or slice of a sphere as previously discussed in this office action.

As previously stated, screw 14 of Marchetti et al. forms "at least a partial seal" by being received and locked in the opening and thus fits in the opening in a "substantially fluid tight" relationship.

Regarding, the limitation "adapted to receive at least an aperture cover, a screw, a peg, and a spike," it has been held that the recitation that an element being adapted to perform a function is not a positive limitation but only requires the ability to so perform and does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Regarding the rejection of claim 47 as being anticipated by Oehy et al., Applicants' arguments are not directed to claim limitations. Applicants' arguments that Oehy et al. disclose a compression screw 14 that is not self-locking is directed to intended use with inadequate recitation of structure to distinguish over the Oehy et al. screw.

Allowable Subject Matter

Claims 53 and 54 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-


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4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR
July 16, 2007


ANURADHA RAMANA
PRIMARY EXAMINER
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